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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/712,584

11/14/2000

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SJO919990173

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01/15/2008

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EXAMINER

O'CONNOR, GERALD J

ART UNIT

PAPER NUMBER

3627

MAIL DATE

DELIVERY MODE

01/15/2008

PAPER

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 20080111

Application Number: 09/712,584  
Filing Date: November 14, 2000  
Appellant(s): Farias et al.

**MAILED**

**JAN 15 2008**

**GROUP 3600**

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David W. Victor  
(Reg. No. 39,867)  
For Appellant

**EXAMINER'S ANSWER**

This examiner's answer has been prepared in response to appellant's brief on appeal  
filed December 4, 2007.

**(1) *Real Party in Interest***

A statement identifying by name the real party in interest is contained in the brief.

*(International Business Machines Corporation)*

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

*(09/712,572.)*

**(3) *Status of Claims***

The statement of the status of claims contained in the brief is correct.

*(Claims 1-69 remain pending, stand rejected, and are appealed.)*

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

*(None.)*

**(5) *Summary of Claimed Subject Matter***

The summary of claimed subject matter contained in the brief is correct.

**(6) *Grounds of Rejection to be Reviewed on Appeal***

The appellant's statement of the grounds of rejection to be reviewed on appeal contained in the brief is correct:

- I. Claims 1-38, 58-67, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art, as described in the written specification, in view of Johnson et al. (US 5,712,989).
- II. Claims 39-57 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art, as described in the written specification, in view of Johnson et al. (US 5,712,989), and further in view of Graves et al. (US H1743).

**(7) *Claims Appendix***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) *Evidence Relied Upon***

The following is a listing of the evidence (e.g., patents, publications, official notice, and admitted prior art) relied upon in the rejection of claims under appeal:

Admitted Prior Art	Written Specification (esp. pages 1, 2, and 6-8).	
US 5,712,989	Johnson et al.	1/1998
US H1743	Graves et al.	8/1998

**(9) *Grounds of Rejection***

I. Claims 1-38, 58-67, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art, as described in the written specification (see, in particular, pages 1, 2, and 6-8), in view of Johnson et al. (US 5,712,989).

The admitted prior art includes a method of ordering products that comprises performing all of the recited sequence of operations/steps/functions, but only includes performing certain of the steps using a computer, leaving other of the steps to be performed manually, and does not appear to include the step of “performing computer-related operations to process information from the supplier indicating a commitment quantity of a number of the products the supplier intends to ship to the RSC to meet the requested quantity.”

However, Johnson et al. disclose a similar method of ordering products, and the method of Johnson et al. indeed includes the step of performing computer-related operations to process information from the supplier indicating a commitment 372 quantity of a number of the products the supplier intends to ship to the RSC to meet the requested quantity.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the known prior art system so as to include the step of performing computer-related operations to process information from the supplier indicating a commitment quantity of a number of the products the supplier intends to ship to the RSC to meet the requested quantity, in accordance with the teachings of Johnson et al., in order to improve the integrity/reliability of the method by making use of computer-based records of orders, inventory, and transactions.

II. Claims 39-57 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art, as described in the written specification (see, in particular, pages 1, 2, and 6-8), in view of Johnson et al. (US 5,712,989), and further in view of Graves et al. (US H1743).

The admitted prior art, combined with Johnson et al., discloses a method of ordering products, as applied above in the rejection of claims 1-38, 58-67, and 69 under 35 U.S.C. 103(a), and Graves et al. further disclose a computer method for ordering products by means of a network of computers, which computer method clearly anticipates the instant claims, except that the method of Graves et al. involves only two entities (a manufacturer ordering directly from a supplier) rather than three entities (a manufacturer, receiving supplies from a distributor/middleman, the distributor/middleman first receiving the supplies from a supplier).

However, the third party distributors/middlemen are well known to those of ordinary skill in the art, hence, obvious elements to include in such a method. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the computer method of Graves et al. so as to duplicate its functionality, as required, to form a three link supply chain instead of a two link supply chain, in order to accommodate an intermediate third party, such as a distributor/middleman, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results, and since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

*St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

**(10) Response to Argument**

I. Claims 1-38, 58-67, and 69 are unpatentable under 35 U.S.C. 103(a) for being obvious over the admitted prior art, as described in the written specification (see, in particular, pages 1, 2, and 6-8), in view of Johnson et al. (US 5,712,989).

Regarding the arguments with respect to claims 1-38, 58-67, and 69 generally, the examiner notes at the outset that, unlike claims 39-57 and 68, none of these claims require any computer performing any of the recited functionality/steps. That is, the computer does not necessarily have to perform the recited steps itself, since the claims read merely on humans performing the steps, using a computer for some steps (e.g., a human composing and sending a message via e-mail or fax, as opposed to the computer actually composing the e-mail itself).

Regarding the argument that the statements made on pages 6-8 of the written specification *cannot* be considered to comprise admissions of prior art simply because the content of those pages is styled as a “Detailed Description of the Preferred Embodiments,” not the “Background Section,” the argument is disingenuous at best, since any admission as to what is or is not previously known is determined by *what* is said, not *where* it is said.

In this case, appellant has stated in the written specification (e.g., on lines 14 and 15 of page 6) that, “The ERP program 50 is a common materials resource planning (MRP) tool used by most manufacturers today.” If appellant has since decided that ERP/MRP systems are *not* prior art, then appellant is certainly welcome to present whatever evidence appellant has to that effect, though any person of ordinary skill in the art would instantly and unquestionably

recognize that such systems are not only known in the prior art, but indeed, are ubiquitous in the prior art. In any event, until any such *evidence* is received, the statements will be construed at face value and deemed admissions of prior art, since it has been held that mere arguments of counsel unsupported by competent factual evidence of record are entitled to little weight. *In re Payne, Durden, and Weiden*, 203 USPQ 245 (CCPA 1979).

Furthermore, it has been held that, “to constitute patentable invention, an aggregation of old unpatentable elements, parts, or substituted equivalents must cooperate to produce new, unobvious, and unexpected result,” as well as that, “ingenious application of known principles to known problem by use of devices already known and understood to produce predictable result does not amount to invention.” *Barrott et al. v. The Drake Casket Company*, 127 USPQ 69 (DC WMich 1960). Therefore, to warrant being rewarded with a patent, appellant’s invention must produce something beyond a completely predictable and non-synergistic result, which it does not.

Regarding the argument that the admitted prior art “does not include” steps that the examiner specifically *stated* in the rejection that it did *not* include, the argument has been disregarded as spurious, since it fails to point out or specify any particular aspect of the rejection that applicant views as improper, and is utterly unresponsive to the actual rejection.

Regarding applicant’s further arguments against the references individually (i.e., that the admitted prior art does not show features taught by Johnson et al., and that Johnson et al. do not show features comprised by the admitted prior art), one cannot show nonobviousness by



attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding the argument that Johnson et al. fail to disclose that “the acquiring entity processes a request from the supplier for information” (i.e., the supplier asks when and how much of what, and the acquiring entity responds to the supplier with the answer), and “then receives information from the supplier indicating a commitment quantity that the supplier intends to ship to meet the acquiring entity’s request” (i.e., the supplier responds with a planned/promised shipment commitment), wherein the supplier uses the answer to the question of when and how much of what to determine what shipment plan/promise/commitment to make (i.e., filling the request/order), the just-in-time system of Johnson et al. obviously indeed includes all such functionality, either explicitly or inherently. Again, the teaching relied upon in Johnson et al. is for performing such functionality via “computer-related” operations as claimed, and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding the argument that the references fail to show certain features of applicant’s invention as recited in claim 18, it is noted that the features upon which applicant relies (i.e., presumably that “pulled by the acquiring entity” can *only* mean “shipped to another company,” as opposed to “merely taken off the shelf by the person who needs it”) are not recited in the

rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding the argument that, if method claims 1, 13, and 18 are patentable, and apparatus claims 20, 32, and 37 recite the functionality of method claims 1, 13, and 18, then the apparatus claims must be patentable as well, the argument has been deemed specious, since a recitation of the intended use of claimed apparatus must result in a *structural* difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is *capable* of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Moreover, apparatus claims must be *structurally* distinguishable from the prior art. *In re Danyl*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device *is*, not what a device *does*.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). See MPEP § 2114 and § 2173.05(g).

Regarding the arguments concerning the *In re Lee* case, *vis-à-vis* the examiner’s statement of what is well known, applicant is confused, because the *In re Lee* case is completely irrelevant to the issue at hand. The *In re Lee* case concerns the issue of

“motivation to combine” whereas the issue at hand is the question of “what is or is not prior art.” In *In re Lee* the Court found that the stated *motivation to combine* two prior art references was improper/insufficient for being too conclusory, since the stated *motivation* was that it was merely common sense or well known. Here, the statement of what is “well known” concerns the “scope and content of the prior art” (one of the findings of fact under the “Graham Factual Inquiries”), not the “motivation to combine” that known prior art with any other prior art (conclusion of law). Such a statement can indeed properly support such a rejection, since, “the rationale supporting an obviousness rejection may be based on common knowledge in the art or ‘well-known’ prior art.” See MPEP § 2144.03. Furthermore, as applicant has failed to seasonably provide any traverse to the examiner’s stated positions as to what is well known prior art, and, as any traverse at this point would no longer be considered seasonable, the objects of the well known statements are therefore now deemed and considered henceforth to be admitted prior art. See MPEP § 2144.03(C), ¶ 2.

To the extent that appellant is arguing that the references applied in the rejection fail to use the same *names/words* for certain elements as the names used by applicant, the argument is irrelevant, as it is noted that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but *need not be in the identical words* as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

To the extent that appellant is arguing that the disclosure in the applied prior art is not in as complete detail as is recited by the instant claims, a reference anticipates a claim if it

discloses the claimed invention such that a skilled artisan could take its teachings *in combination with his own knowledge* of the particular art and be in possession of the invention. *In re Graves*, 36 USPQ2d 1697 (Fed. Cir. 1995); *In re Sasse*, 207 USPQ 107 (CCPA 1980); *In re Samour*, 197 USPQ 1 (CCPA 1978).

To the extent that appellant is arguing that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case the knowledge generally available to one of ordinary skill in the art would include the necessary motivations and suggestions to combine the references, as set forth in the applied rejection(s).

II. Claims 39-57 and 68 are unpatentable under 35 U.S.C. 103(a) for being obvious over the admitted prior art, as described in the written specification (see, in particular, pages 1, 2, and 6-8), in view of Johnson et al. (US 5,712,989), and further in view of Graves et al. (US H1743).

Regarding the arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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Note that, although all claims have been interpreted in light of the specification, limitations from the specification have not been read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Additionally, during patent examination, the pending claims must be interpreted as broadly as their terms reasonably allow. See *In re Zletz*, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

To the extent that appellant is arguing that the disclosure in the applied prior art is not in as complete detail as is recited by the instant claims, a reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention. *In re Graves*, 36 USPQ2d 1697 (Fed. Cir. 1995); *In re Sasse*, 207 USPQ 107 (CCPA 1980); *In re Samour*, 197 USPQ 1 (CCPA 1978).

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modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case the knowledge generally available to one of ordinary skill in the art would include the necessary motivations and suggestions to combine the references, as set forth in the applied rejection(s). It is the finding of the examiner that making such a modification/combination could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results, and it has been held that the main test for the tenability of any conclusion of obviousness with respect to any proposed or hypothetical combination or modification of prior art knowledge is whether or not such a combination or modification could have been performed or implemented by any person of ordinary skill in the art seeking to solve the same problem, at the time of the invention, with neither undue experimentation, nor risk of unexpected results. See *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379.

Moreover, "to constitute patentable invention, an aggregation of old unpatentable elements, parts, or substituted equivalents must cooperate to produce new, unobvious, and unexpected result," as well as that, "ingenious application of known principles to known problem by use of devices already known and understood to produce predictable result does not amount to invention." *Barrott et al. v. The Drake Casket Company*, 127 USPQ 69 (DC WMich

1960). Therefore, to warrant being rewarded with a patent, appellant's invention must produce something beyond a completely predictable and non-synergistic result, which it does not.


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**(11) *Related Proceeding(s) Appendix***

No decision rendered by any court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For all of the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,


  
1/11/08  
Gerald J. O'Connor  
Primary Examiner  
Group Art Unit 3627

GJOC

January 11, 2008

Appeal Conference Held:

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Application: 09/712,584

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